

*** * REASONS FOR AMENDMENTS AND REMARKS * ***

Applicants wish to acknowledge with appreciation the Examiner's analysis and efforts in examining this application.

On page 2 of the Official Action, the Examiner rejected Claims 5 and 7-11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. The Examiner asserts that there is no clear antecedent basis for "the at least one jaw member" (Claim 5), "[t]he modular gripper assembly" (Claims 8-11), "the through-slot" (Claim 8), "the first locking segment" (Claim 9), "the second locking segment" (Claim 10), or "the first and second locking segments" (Claims 11). The Examiner also asserts in Claim 7, line 6, that it is unclear whether the phrase "the jaw member" is referring to the *first* or the *second* jaw member.

Claim 5 has been canceled. Claims 7 through 11 have been amended to clarify any antecedent basis issues identified by the Examiner. Claims 8, 9, and 11 have also been amended to depend from Claim 7, while Claim 10 has been amended to depend from Claim 9.

On pages 3 and 4 of the Official Action, the Examiner rejected Claims 1, 6, 8, and 9, as understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Jackson (U.S. Pat. No. 5,085,480). The Examiner alleges that Jackson shows a gripper having a cam slot (60) in each jaw member wherein the cam slots have a pivoting portion (62) and a locking portion (66).

With regard to Claim 7, Applicants respectfully submit that Jackson cannot serve as a basis for rejection under § 102(b) because Jackson does not disclose or teach every limitation of Claim 1. Claim 1 contains the limitation "wherein the distance between the cam walls of the locking portion is substantially equal to the distance between the cam walls of the pivoting portion[.]" Upon examination of FIG - 5, it is clear that Jackson fails to disclose this

limitation within its teaching. Specifically, FIG - 5 of Jackson shows a cam 60 as having a first linear portion 62 and a second angular portion 66. The arrow pointing to “66” is clearly pointing to an area along cam 60 where the contour is different than that of the directly-opposing wall portion of cam 60. The distance between the cam walls at this point does not appear substantially equal relative to the remaining opposing portions of the cam walls. The change in contour appears, based on the specification, to allow members 86 to enter second angular portion 66, which locks members 40, 42 about a workpiece. The distance between the walls of cam 60 appears to allow the locking to take place. Jackson, therefore, does not contain the aforementioned limitation. In light of the foregoing, Claim 1 is respectfully believed to be in condition for allowance.

Claim 6 is believed to be in condition for allowance in light of the foregoing analysis. Claims 8 and 9 have been amended to depend from Claim 7, and are now believed to be in condition for allowance.

The Examiner also determined that Claims 7-11, as understood, are rejected under 35 U.S.C. § 102(b) as being anticipated by Forster et al. (U.S. Pat. No. 4,886,635). The Examiner alleges that the patent to Forster shows two pivotable jaws (5, 6) each comprising through slots (5a, 6a) having angled locking segments at each closed end thereof.

With regard to Claim 7, Applicants respectfully submit that Forster cannot serve as a basis for rejection under § 102(b) because Forster, too, fails to disclose or teach every limitation of Claim 7. In the Examiner’s rejections based upon 35 U.S.C. § 103(a), the Examiner has characterized Forster further by alleging that it may be used to teach “angled locking portions” (or segments) at the end of cam slots in order to secure the jaws in either an open or closed position until driven by an actuator. This characterization demands that Forster teach that the cam slot shape contribute to securing jaws in an open or closed position absent actuation of the jaws. However, upon examination of Forster, guide grooves 5a, 6a shown in FIG 1 and FIG

2 do not appear to contribute to catches 5, 6 being locking into position in the event of a sudden reduction of pressure in control lines 22a. Upon review of FIGS 1 and 2, as well as the specification of Forster, guide pins 14, 15 appear to be disposed in a portion of guide grooves 5a, 6a that are generally parallel to the path of sleeve bushing 13 along guide rod 4. Return springs 23 are described in the specification as being in cylinders 19 to “assure that the pistons 20 remain in the upper position and the catches 5, 6 remain closed, in case of a sudden reduction of pressure in the control lines 22a.” (Col. 3, Lines 27-30.) If catches 5, 6 were in the position shown in FIG 2 and return springs 23 were absent, a sudden reduction in pressure in control lines 22a would appear to cause sleeve bushing 13 to drop along guide bar 4 under the force of gravity to that of the position shown in FIG 1. This would move guide pins 14, 15 along guide grooves 5a, 6a, respectively, thereby opening catches 5, 6. The shape of guide grooves 5a, 6a appear not to have any effect on keeping catches 5a, 6a in a closed position. Without return springs 23 or pressure in control lines 22a, sleeve bushing 13 would be free to move along guide bar 4 to open or close catches 5, 6. The specification is without language that contradicts this interpretation of Forster. Forster, therefore, does not contain an “angular locking segment” that secures the jaws in either an open or closed position until driven by the actuator. An affidavit in support of this argument from Mr. McIntosh, one of the named Applicants is being filed concurrently herewith.

Furthermore, the phrase “locking segment” correctly identifies the limitation to mean a segment of the claimed “through-slot” that actually locks. The word “locking” in Claim 7 acts as a present participle, which describes what the modified noun “segment” actually does. In this case, the segment locks. The segment is claimed as performing the act of locking, which Forster does not teach. In light of the foregoing analysis, Claim 7 is believed to be in condition or allowance.

The Examiner has rejected Claims 1, 2, and 4-11, as understood, under 35 U.S.C. § 103(a) as being obvious under British Patent #2,041,263 in view of Forster. The Examiner

alleges that the cam slots (13, 14) for the British ('263) patent are not distinctly divided into pivoting portions and locking portions as called for in the claims of the instant application.

However, the Examiner states (as pointed out above), the Forster patent shows cam slots (5a, 6a) in each of its jaws wherein the slots are formed with angled locking portions at each end with a pivoting portion disposed therebetween. The Examiner asserts that accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form angled locking portions at each end of the British ('263) cam slots as taught by Forster in order to secure the jaws in either an open or closed position until driven by the actuator.

To establish a *prima facie* case of obviousness, as is the case with this present rejection, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references, or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

Specifically regarding motivation and likelihood of success, hindsight reconstruction cannot be used to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). *Panduit Corp. v. Dennison Manufacturing Co.*, 227 USPQ2d 337, 343 (CAFC 1985). *In re Shuman*, 150 USPQ 54, 57 (CCPA 1966). Motivation and likelihood of success must, therefore, exist in the prior art references themselves, and not in the presently claimed invention.

Applicants respectfully submit that there is no teaching or motivation in Forster to combine British with an “angled locking portion” to secure the jaws in either an open or closed position until driven by the actuator. As discussed above, Forster does not teach that guide grooves 5a, 6a can secure catches 5, 6 in an open or closed position. As required under *In re Vaeck*, the prior art references must teach or suggest all the claim limitations to establish a prima facie case for obviousness, which in this case, Forster and British fail to do. In light of this previous analysis, Claim 7 is respectfully believed to be in condition for allowance.

Claims 8 and 9 have been amended to depend from Claim 7. In light of the foregoing analysis regarding Forster, Applicants respectfully believes that Claims 8-11 are in condition for allowance.

The Examiner rejected Claim 3 under 35 U.S.C. 103(a) as being obvious under British Patent # 2,041,263 in view of Forster et al. as applied to claims 1 and 2 above, and further in view of Kraft. The Examiner alleges that Kraft shows a pair of pivotal jaws each having a cam slot (7) disposed therethrough. One portion of the slots is curved to create maximum pivotal movement. The Examiner contends it would have been obvious to a person having ordinary skill in the art to at least slight curve the pivoting portion of the modified British (‘263) cam slots, as presented supra, as taught by Kraft in order to create maximum pivotal movement relative to the linear motion of the actuator.

In light of the foregoing analysis concerning Forster, Applicants respectfully believe that Claim 3 is in condition for allowance.

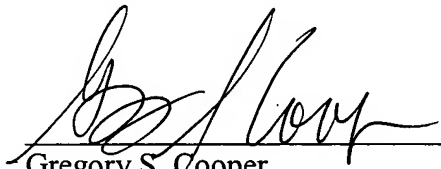
It is believed that the above represents a complete response to the Official Action and favorable reconsideration by the Examiner is requested. The proposed amendments do not raise new issues that would require further consideration and/or search, do not raise the issue of new matter, do not increase the number of claims in the application, and are deemed to place the

application in better form for either allowance or appeal by reducing or simplifying the issues for appeal.

If, upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact Applicants' patent counsel at the telephone number given below to discuss such issues.

A Petition for Extension of Time under 37 C.F.R. §1.136 accompanies the filing of this document. To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. To the extent additional fees are required, please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 02-1010 (614359/82664) and please credit any excess fees to such deposit account.

Respectfully submitted,



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